



Docket No.: 1046.1243

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Makoto SUZUKI, et al.

Serial No. 09/788,387

Group Art Unit: 2612

Confirmation No. 5408

Filed: February 21, 2001

Examiner: Villecco, John M.

For: IMAGE PHOTOGRAPHING SYSTEM HAVING DATA MANAGEMENT FUNCTION,
DATA MANAGEMENT DEVICE AND MEDIUM

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed March 3, 2006, having a reply due date of May 3, 2006, Applicants hereby submit this Reply Brief.

A Request for Oral Hearing is submitted herewith.

I. STATUS OF CLAIMS (37 CFR § 41.37(c)(1)(iii))

Claims 1, 4, 5, 7-9, 12-14 and 16 are pending, claims 10, 11 and 15 remain withdrawn and claims 2, 3 and 6 remain cancelled. Claims 1, 4, 5, 7-9, 12-14 and 16 stand finally rejected and are appealed.

Claims 1, 4, 5, 7-9, 12-14 and 16 are each independently patentable over the references, and as set forth below, and do not stand or fall together.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR §41.37(c)(1)(vi))

Claims 1, 4, 7, 8, 12 and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,515,704 (Sato).

Claims 5, 9, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato and U.S. Patent No. 5,943,050 (Bullock). (Claims 2, 3 and 6 stand cancelled and claims 10, 11 and 15 remain withdrawn).

III. ARGUMENT (37 CFR § 41.37(c)(1)(vii))

A typical order of displaying digital images is dictated by predetermined characteristics of the digital images such as a file name, a recordation date, etc., and prevents a user from dictating the display order.

The present invention enables a user to freely insert an image at a desired position within a sequence of image data including between images in the sequence of image data. For example, as illustrated in FIG. 7 of the present application, a user is able to drag image display frame 32c from frame 3 to frame 1. That is, the present invention does not restrict insertion of images at a predefined position in the sequence of image data.

The Examiner's Answer includes Grounds of Rejection in item (9) on pages 3-6 that appear to be identical to items 5-17 on pages 3-7 of the Office Action mailed June 2, 2005. Since these rejections were addressed in the Appeal Brief, these rejections are not addressed in this Reply Brief. Following is the Appellant's reply to the comments in item (10) of the Examiner's Answer.

In item (10) of the Examiner's Answer, the Examiner refers to the Appeal Brief filed on February 2, 2006. Specifically, the Examiner appears to indicate that the sole argument in Applicants Appeal Brief is directed towards Sato failing to disclose "inserting the image data in a desirable position of said sequence of image data" (claim 1 and 7), "inserting the image data in a

desirable position of said sequence listing of image data" (claim 12) and the feature of claim 16 where "the generated image data is automatically stored at a selected position of the displayed sequence of stored image data."

However, as discussed in previous responses, for example, the Amendment filed on December 20, 2004 and on pages 6-8 of the Appeal Brief filed on February 2, 2006, independent claims 1, 7 and 12 recite, "displaying a screen configured by a first display area displaying an image from an image acquisition device" and "a second display area displaying a sequence of image data." Independent claims 1, 7 and 12 also recite, "detecting a photographing instruction", "generating image data from the image when detecting the photographing instruction" and inserting the image data "a desirable position of said sequence of image data."

Independent claim 16 recites, "a first display area displaying an image from the image acquisition device and a second display area displaying a sequence of stored image data" and "acquiring the image from the image acquisition device and generating image data related to the acquired image." Independent claim 16 further recites, "the generated image data is automatically stored at a selected position of the displayed sequence of stored image data in accordance with a user's instruction when the image is acquired."

Sato provides a display screen with a main image display portion (101) at the center of the screen for displaying a photographing preview and a plurality of subwindows (102-113) surrounding the main image display (101) for viewing thumbnail images (see, col. 4, lines 32-40 and FIG. 2). Then, when it is determined that a photographing operation is performed (i.e., user depresses the shutter), the thumbnail images displayed on the subwindows (102-113) at the peripheral portion of the main image display (101) are updated so that the thumbnail image of the new photograph is placed in an appropriate one of the subwindows (102-113) (see, col. 4, line 64 through col. 5, line 9). That is, Sato is limited to placing the thumbnail image resulting from the photographing operation in the sub subwindows (102-113).

Unlike Sato, the present invention does not have the limitations discussed in the previous paragraph. For example, the image display area 21 ("first display area") is able to display the latest image photographed by the image acquisition device in the monitor mode, and display digital data of an already photographed image that is stored in the hard disk in the review mode (see also, page 11, lines 9-15 of the present application).

Sato does not teach or suggest, "first display area displaying an image from the image acquisition device" and "second display area displaying a sequence of stored image data", as recited in each of the independent claims 1, 7, 12 and 16.

Thus, Applicants respectfully submit that inserting image data in "a desirable position of said sequence of image data", "a desirable position of said sequence listing of image data" and where "the generated image data is automatically stored at a selected position of the displayed sequence of stored image data", discussed in the Appeal Brief filed on February 2, 2006, are not the only distinguishing features of claims 1, 7, 12 and 16.

The Examiner acknowledges that Sato "only allows insertion at restricted position", but the Examiner appears to interpret these restricted positions in Sato as being desirable positions.

Sato, at col. 4, lines 42-51, specifically states that the thumbnail images are sequentially displayed in the subwindows (102-113) in time series, in the clockwise direction every time a new image is photographed (see, col. 5, lines 10-16), or at a predetermined window set as the initial position (see, col. 6, lines 35-39). That is, Sato predefines the display positions of the thumbnail images to restricted positions and does not have the capability or provide an option for inserting the images at desirable positions.

The Examiner further states that the restricted positions in Sato are presumed to have desirable specific reasons. However, Sato, at col. 6, lines 31-50, portions of which the Examiner refers to, specifically state:

"In the first embodiment, as shown in FIG. 4, thumbnail image are sequentially additionally displayed in the clockwise direction on the subwindows at the peripheral portion of the screen every time a new image is photographed. However, the present invention is not limited to this. For example, the latest image may be always displayed on a predetermined window set as the initial position, and the thumbnail image previously displayed on the subwindow may be shifted in the clockwise direction and redisplayed. FIG. 8 shows this example. In FIG. 8, the latest thumbnail image is always displayed on the subwindow 102. When a photographing instruction for the preview image which is being currently displayed at the main image display portion 101 is generated, the preview image is stored in the storage section 8, and simultaneously, the thumbnail image of the image is displayed on the subwindow 102. At this time, the thumbnail images displayed on the subwindows 102 to 104 are sequentially shifted by one area to the subwindows 103 to 105, respectively, and displayed, as shown at the lower half of FIG. 8."

As can be seen from the above-discussion, these portions of Sato specifically limit the placement positions of the images (i.e., clockwise direction, subwindow (102), etc.) to predefined positions. Thus, the Examiner has not met the burden of establishing a prima facie case of

obviousness because the Examiner implies the reasons for Sato's prescribed placement of the images.

The Examiner further acknowledges that Sato does not enable a user to insert the newly photographed image into a desired subwindow, but the Examiner asserts that the claims do not require that a user be able to manually select a position into which the image is placed (see, last paragraph on page 8 of the Examiner's Answer). Applicants respectfully disagree. For example, independent claim 16 recites that image data related to the image acquired "from the image acquisition device" is automatically stored at a selected position of the displayed sequence of stored image data "in accordance with a **user's instruction** when the image is acquired" (emphasis added).

On page 9 of the Examiner's Answer, the Examiner asserts that the "user's instruction" is interpreted to be the user's depression of the shutter button in the operation section. Applicants respectfully disagree because, claim 16 recites, "acquiring the image from the image acquisition device" and then, "generating image data related to the acquired image", where the generated image data is stored at "a selected position" in accordance with "a user's instruction."

Applicants respectfully submit that the Examiner is reading the claims in a vacuum and erroneously interprets the claims without the Specification of which they are a part.

For example, as discussed in the Specification of the present application, a user operation recognizing module (element 5 in FIG. 4) recognizes which data is transferred and where, and which icon is depressed by the user's operation (see, page 15, lines 10-17). As further discussed in relation to FIG. 7, the user's operation (e.g., drag-and-drop) causes the image display frame to be moved in a desired direction and be inserted in a desired position (see also, page 18, line 18 through page 19, line 3).

The Examiner is requested to interpret the claims "...taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification" as required by MPEP § 2111.01 (see also, *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation" 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976))).

Moreover, in contrast to Sato, the present invention provides the user the capability of defining a "a selected position" at which the image is to be placed based on "a user's instruction" after "acquiring the image from the image acquisition device."

Similarly, independent claims 1, 7 and 12 similarly recite, "generating image data from the image when detecting the photographing instruction" and "inserting the image data in a desirable position of said sequence of image data." That is, unlike Sato, where insertion is restricted to specific positions, the present invention enables insertion of the image data at a desired position of the user, which is manually specified or by programming the system, to automatically place the image in the desired position.

Bullock adds nothing to the limitations of Sato discussed above. Specifically, Bullock is limited to displaying sequentially captured images on a work-surface of the computer display and only displays a captured image adjacent to an image capture window (see, col. 6, lines 3-6, FIGS. 5 and 6 and corresponding text).

Sato and Bullock, alone or in combination, do not teach or suggest the above-discussed features of independent claims 1, 7, 12 and 16.

For at least the above-mentioned reasons, claims depending from claims 1, 7, 12 and 16 are patentably distinguishable over Sato and Bullock. For example, as recited in claim 4, when image data is inserted in the desired position within the sequence of image data, "the image data already displayed are shifted frame by frame in a predetermined direction and thus displayed." Sato and Bullock, alone or in combination, do not teach or suggest these features of claim 4 (see also, claims 8 and 13).

Therefore, it is respectfully submitted that the present invention is patentably distinguishable over Sato and Bullock.

IV. CONCLUSION

For the reasons set forth above, it is submitted that the Examiner's Answer does not rebut the arguments presented in the Appeal Brief and during prosecution of the present application.

Therefore, it is respectfully submitted that the Examiner's final rejection of the claims is without support and erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any additional fees are required in connection with the filing of this Reply Brief, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 05/03/2006

By: 
Temnit Afework
Registration No. 58,202

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

V. CLAIMS APPENDIX (37 CFR § 41.37(c)(1)(viii))

1. (PREVIOUSLY PRESENTED) An image photographing system, comprising:
a display unit displaying a screen configured by a first display area displaying an image from an image acquisition device, and a second display area displaying a sequence of image data;

a detecting unit detecting a photographing instruction;

a generating unit generating image data from the image when detecting the photographing instruction; and

an inserting unit inserting the image data in a desirable position of said sequence of image data.

2. (CANCELLED)

3. (CANCELLED)

4. (PREVIOUSLY PRESENTED) The image photographing system according to claim 1, wherein when the inserting unit inserts the image data in the desirable position of said sequence of image data, the image data already displayed are shifted frame by frame in a predetermined direction and thus displayed.

5. (PREVIOUSLY PRESENTED) The image photographing system according to claim 1, wherein the image acquisition device is an outside device.

6. (CANCELLED)

7. (PREVIOUSLY PRESENTED) A storage medium readable by a machine embodying a program of instructions executable by the machine to perform operations, comprising:

displaying a screen configured by a first display area displaying an image from an image acquisition device, and a second display area displaying a sequence of image data;

detecting a photographing instruction;

generating image data from the image when detecting the photographing instruction;

and

inserting the image data in a desirable position of said sequence of image data.

8. (PREVIOUSLY PRESENTED) The storage medium readable by a machine embodying the instructions executable by the machine according to claim 7 to perform further operations, comprising:

shifting the already-displayed image data frame by frame in a predetermined direction when displaying new image data in a predetermined position when the new image data is inserted in the desirable position of said sequence of image data.

9. (PREVIOUSLY PRESENTED) The storage medium readable by a machine embodying the instructions executable by the machine according to claim 7, wherein the image acquisition device is an outside device.

10. (WITHDRAWN) A data management device comprising:

a display screen arranging and displaying a predetermined number of data identifying elements identifying data,

wherein if the number of pieces of data to be managed exceeds the number of pieces of data displayable on said display screen and if data to be managed is added, the added data is inserted in a layout of the data identifying elements displayed.

11. (WITHDRAWN) A storage medium readable by a machine, tangible embodying a program of instructions executable by the machine to perform method steps for making a computer manage data, the method steps comprising:

arranging and displaying a predetermined number of data identifying elements for identifying data;

adding data to be managed; and

inserting and displaying the added data in a layout of the data identifying elements displayed if the number of pieces of data to be managed exceeds the number of pieces of data displayable on a display screen and if data to be managed is added.

12. (PREVIOUSLY PRESENTED) An image photographing method, comprising:

detecting a photographing instruction;

displaying a screen configured by a first display area displaying an image from an image acquisition device, and a second display area displaying a sequence of image data;

generating image data from the image when detecting the photographing instruction;

and

inserting the image data in a desirable position of said sequence listing of image data.

13. (PREVIOUSLY PRESENTED) The image photographing method according to claim 12 further comprising:

shifting the already-displayed image data frame by frame in a predetermined direction when displaying new image data in a predetermined position when the new image data is inserted in the desirable position of said sequence of image data.

14. (PREVIOUSLY PRESENTED) The image photographing method according to claim 12, wherein the image acquisition device is an outside device.

15. (WITHDRAWN) A data managing method comprising:
arranging and displaying a predetermined number of data identifying elements for identifying data;

detecting command adding data to be managed; and inserting and displaying the added data in a layout of the data identifying elements displayed if the number of pieces of data to be managed exceeds the number of pieces of data displayable on a display screen and if data to be managed is added.

16. (PREVIOUSLY PRESENTED) A computer readable storage medium storing a program executable by a computer connected with an image acquisition device to perform operations, comprising:

providing a first display area displaying an image from the image acquisition device and providing a second display area displaying a sequence of stored image data; and

acquiring the image from the image acquisition device and generating image data related to the acquired image, wherein the generated image data is automatically stored at a selected position of the displayed sequence of stored image data in accordance with a user's instruction when the image is acquired.